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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/656,581	09/06/2000	Robert Filepp	IBM-FILEPP ET AL. 012 PCS	9843

7590 05/06/2003

PAUL C. SCIFO
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10 LEE COURT
FRANKLIN SQUARE, NY 11010

[REDACTED] EXAMINER

DINH, DUNG C

ART UNIT	PAPER NUMBER
2153	/2

DATE MAILED: 05/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

Office Action Summary	Application No.	Applicant(s)
	09/656,581	FILEPP ET AL.
	Examiner Dung Dinh	Art Unit 2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-51 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-51 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

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DETAILED ACTION

1. Prosecution is being reopened on this application because further review of the copied claims shows the application is not in condition for allowance. As not all matters were adequately addressed in the earlier prosecution of this application; as some new information that raise substantial issues as to patentability has recently come to the attention of the examiner [the result of the review of the reconstructed application 07/388,156 and art cited in one of applicants' related applications on appeal (see the 35 USC § 102(b) discussion which follows)]; and because of double patenting rejections resulting from the issuance of some of applicants' other applications during the intervening period, the applicants will find that this Office action addresses the now determined remaining outstanding issues and rejections. A declaration of interference with U.S. Patent 5,948,061 (Merriman '061) would be premature until all matters involving these grounds of rejections are resolved. The Office regrets any inconvenience that may have arisen from the delay in the prosecution of this application. This application will receive expedited priority in all matters wherever possible to mitigate any impact caused by these developments.

Inquiry under 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. An issue as to the patentability of the claimed subject matter because of public use or on sale activity has been raised by the applicant in this application. It is necessary to resolve this issue before a conclusion as to the patentability of the claimed subject matter can be reached. In the recently reconstructed application 07/388,156 (now U.S. Patent 5,347,632), a paper was found which was a disclosure statement by applicants' representative, Mr. Paul Scifo. The paper

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was filed under 37 CFR 1.97 (Paper no. 13, filed March 4, 1991) and it addresses matters regarding possible public use or on sale in this country more than one year prior to the date of the application for patent. In the preliminary papers filed on September 6, 2000 in the instant application (09/656,581), Mr. Paul Scifo makes the statement that Applicants is entitle to a priority date of July 28, 1989. Since the July 28, 1989 date is the filing date of application 07/388,156, it appears applicants are conceding the priority of two of the related applications, which date back to July 15, 1988 (for original filed application 07/219,931). The record is therefore unclear relating to the dates stated in the disclosure statement filed March 4, 1991 for the public use or on sale of the *currently claimed invention*.

4. The disclosure statement refers to three phases of testing and development extending over almost two years (see page 15, lines 1-4).

Phase I	January-September '87 "testing was conducted confidentially by Prodigy employees and outside consultants". Goal: To "establish the viability of the general concept."
Phase II	October '87- March '88 Testing expanded to 3 groups of approximately 100 people each. Goal: (1) to determine if the service would continue to operate with users who were not involved in the development, and (2) to fix problems as they occurred.
Phase III	April-August 1988 "Founding Members". Goal: Public testing "over a broader user base to see if the reception system and Service would continue to operate." [page 20, lines 10-16]

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5. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required, and must be submitted with the response to this Office action as part of a complete reply, as follows:

- a) The statement is signed by the attorney of record. Please respond as to whether this statement is a personal knowledge, firsthand account. It is being treated as an admission by applicants through their appointed representative. Any information necessary to refute statements made herein must be made in the form of evidence.
- b) The disclosure statement contains many statements regarding the development of the service through various phases. As there is no **substantive** discussion of what features were implemented in the various releases/releases, applicants are required to provide evidence to clarify the relationship between the **currently pending claims** and the initial implementation and all subsequent significant revisions, and in particular to indicate the revision level and date of implementation that the service met the currently claimed subject matter.
- c) As the statement's introductory section appears to be a list of features embodied in the original design that appears to encompass the details of all the claims, applicants are required to provide evidence of what **claimed** features were not present in the original embodiment, particularly by identifying at what stage/revision each missing claimed feature was added. This evidence should include dates wherever possible.
- d) Applicants are required to provide evidence to explain what each stage of experimentation was designed to test. This evidence is to also indicate what features had been added, enhanced and/or improved at each deployment.
- e) Applicants are required to provide copies of documentation supplied to any testers at each of the phases. This documentation should include, but is not limited to, a description of the service, test conditions or goals, any restrictions on use and dissemination, and contracts/agreements regarding confidentiality.

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- f) Applicants are required to clarify the relationship between the testing and the currently pending Claims 1-51 and identify when and what types of substantive changes were made at each deployment or revision. A table lining up claimed elements and the testing phases would be a useful format for conveying this relationship.
- g) Applicants are required to state what measures were in place to ensure the confidentiality discussed on page 17 of the disclosure statement.
- h) Since the disclosure statement states there were no confidentiality requirements during Phase III when using 2600 additional members of the public ("the Founding Members," see page 21, lines 23-24) during the period of April – August 1988, more information is needed from applicants to resolve the issue as to public use. The implementation and functionality of the system at this stage and any evidence which applicants believe would support a conclusion of non-public use would be of great value to the examination process.
- i) According to the disclosure, the Founding Members were given an option to get an extension of service at a reduced rate (see page 21, lines 2-4). Applicants are required to describe these offers including the dates they were made. Applicants are also required to submit information regarding responses to these offers including the dates of the first acceptance of any of these offers.
- j) Applicants are required to provide information regarding the sponsor agreements and the "understanding with approximately 6 chain distributors." (See page 24, 2nd and 3rd paragraphs.) The contracts in place and any evidence of either oral or written agreements should be provided wherever possible.
- k) Applicants may wish to submit evidence that the revised version release which occurred on or about August 5, 1988 had significant differences from the previous versions which may be reflected in the currently pending Claims 1-51.

The examiner takes note of the disclosure statements' citation of case law that addresses the interplay between experimental and public use; control and incidental payments. As mentioned in the statement, the determination is based on the totality of the circumstances. Therefore the

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examiner needs the required information and evidence in order to evaluate the facts and resolve the patentability issue as to whether applicants' actions constitute a statutory bar.

In responding to this inquiry, applicants are also advised to carefully consider the references cited on the PTO-892 relating to the Trintex system (now known as "Prodigy"), its design and deployment. This art dates back to 1987 and appears to outline applicants' invention, particularly in articles dated Sep 8, 1987, October 12, 1987, and November 30, 1987.

Applicants are reminded that this requirement is an integral part of this Office action, and failure to fully reply to this requirement for information will result in a holding of abandonment.

Information Disclosure Statement

6. The art made of record and not relied upon is considered pertinent to applicant's disclosure. (IDS filed on 5/13/02 as paper #6).

- Antone F. Alber, Videotex/Teletex Principles and Practices, 1985
- Jan Gecsei, The Architecture of Videotex Systems, 1983
- Paul Hurly et al., The Videotex and Teletext Handbook, 1985
- Cleveland Horton, IBM, Sears shooting for '88 entry; New life for videotex, April 6, 1987
- Ellen Forman, Surge seen for electronic shipping, May 21, 1987
- Jerrold Ballinger, Trintex Signs up 42 Advertising Clients: Is Hoping for Launch in Early '88, VP Says, June 1, 1987
- Cleveland Horton, Big advertisers link to videotex venture, June 15, 1987
- Arthur Markowitz, Trintex interactive videotex service will feature magazine-type format, June 22, 1987
- Trintex to Aim On-Line Ads at Demographic Segments, June 30, 1987
- Inside Trintex; Technology & Operations supplement, Sep 8, 1987
- David Kiley, Trintex: Videotex Gets Personalized, October 12, 1987.
- Scott Mace, Trintex System Offers Access to Variety of Consumer Services, Nov 30, 1987

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Hill v. CompuServe, 57 USPQ2d 1021 (S.D. Ind. 2000)(unpublished); *aff'd, rev'd-in-part, vacated-in-part, and remanded*, 33 Fed. Appx. 527; 2002 U.S. App. Lexis 6895 (CAFC 2002).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Dinh whose telephone number is (703) 305-9655. The examiner can normally be reached on Monday - Thursday from 7:00 AM to 4:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone *regarding this application only* are unsuccessful, contact the Special Programs Office, Josie A. Ballato, who can be reached on (703) 308-0269. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2100 Customer Service Office whose telephone number is 703-306-5631.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

(703) 746-7239, (for formal communications intended for entry)

(703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (Receptionist).



Dung Dinh

Primary Examiner

May 1, 2003